

REMARKS

Initially, Applicants have amended claims 194, 237, 263-265, 272-279, 281-282, and 284 to more accurately claim the present invention and not for any reason related to patentability. No new matter has been added. Applicants believe that the following comments overcome the rejections set forth in the February 28, 2003 Office Action and that the rejections should be withdrawn.

10 I. **THE INVENTION**

Generally, the present invention is a system for accessing electronic data via a familiar printed medium. Specifically, the familiar printed medium is a printed ticket of admission. Also, the machine recognizable feature may be one of various embodiments including, but not limited to, a watermark, bar code, invisible bar code, magnetic code, printed character, invisible icon, etc. When a machine recognizable feature is recognized, an electronic signal is transmitted for processing. The processing results in the display of programming material related to the information contained in the printed ticket of admission. Importantly, the present invention is designed to allow a user to access programming material related to the information contained in the printed ticket

of admission to supplement the information provided by the printed ticket of admission.

II. THE EXAMINER'S REJECTIONS

5 A. 35 U.S.C. § 102(b)

 The Examiner rejected claims 168-169 under 35 U.S.C. § 102(b) as being anticipated by Withnall *et al.* U.S. Patent No. 4,488,035 (hereinafter referred to as "Withnall"). Initially, the Examiner argued that Withnall discloses a
10 transport system having a microprocessor-based, optical ticket reader that reads information from a printed ticket to determine and display the validity of the ticket. Also, the Examiner explained that a microprocessor-based ticket printer is used to issue bar-coded tickets. The Examiner
15 then indicated that reference information is stored in memory which communicates with the ticket-checking means. The Examiner concluded therefrom that Withnall discloses the invention claimed in claims 168-169.

20 B. 35 U.S.C. § 103(a)

 The Examiner rejected claims 170-278, 280-281, and 283-284 under 35 U.S.C. § 103(a) as being unpatentable over Withnall "in view of the general teachings of the prior art of record." (February 28, 2003 Office Action Summary, p.

4). The Examiner admitted that the rejected claims differ from Withnall by claiming different types of codes, networks, and data. The Examiner contended that all of these differences would have been obvious variations of
5 Withnall.

To support the aforementioned conclusions, the Examiner cited Veeneman *et al.* U.S. Patent No. 5,243,174 (although Applicants believe that the examiner meant to cite U.S. Patent No. 5,774,874 (hereinafter referred to as
10 "Veeneman")); Montanari *et al.* U.S. Patent No. 5,478,990 (hereinafter referred to as "Montanari"); and Sangster U.S. Patent No. 4,609,358 (hereinafter referred to as "Sangster").

Regarding Veeneman, the Examiner stated that a system
15 that includes a bar code scanner is disclosed such that the bar code scanner:

"could be located in a registrant's home such that the registrant could register for items from multiple merchants via a catalogue that includes
20 bar codes for the items. The registrant would communicate to the kiosk via remote communication, such as a modem or the InterNet. The term catalog should be understood to be not limited to a physical paper catalog, but also

encompasses things such as CD-ROMs, and other data storage devices." (February 28, 2003 Office Action Summary, p. 5).

With respect to Montanari, the Examiner pointed to a
5 method for tracking the production history of a particular food product. Specifically, tags encoded with tracking numbers are used to track an animal's meat product throughout the growing and production process.

"As ownership and possession of an animal is
10 transferred, the Animal Tracking Number (A-TN) is recorded on a tag, preferably in an electronic or computer readable form, such as a bar-code or magnetic strip, and vital information ... may be added to the database record via such tag at
15 various times in the growth of the animal, as well as in the fabrication process." (February 28, 2003 Office Action Summary, p. 6).

Regarding Sangster, the Examiner noted that the disclosure provides student stations comprising
20 microcomputers whereon responses to situations presented on a television or videodisc player may be entered. Further, student responses cause the appropriate output to be sent to the television monitors or cause the videodisc player to access the appropriate portion of the videodisc.

III. THE EXAMINER'S REJECTIONS SHOULD BE WITHDRAWN

A. 35 U.S.C. § 102(b)

The Examiner rejected claims 168-169 under 35 U.S.C. §
5 102(b) as being anticipated by Withnall. Applicants
respectfully disagree. Specifically, Withnall does not
disclose the programming material of the claimed invention.
The programming material of the present invention is
designed such that it can be easily altered or updated at
10 any time. As a result, a user will be provided with the
most recently updated version of the associated information
(or programming material) upon scanning a printed ticket of
admission. Withnall, on the other hand, scans a commuter
ticket to ascertain a validity state associated with that
15 ticket. However, at no point does Withnall provide more
substantial programming material which includes various
supplemental information corresponding to the printed
ticket of admission. Therefore, Applicants respectfully
submit that Withnall does not disclose each and every
20 element of claims 168-169 and therefore, does not
anticipate these claims.

B. 35 U.S.C. § 103(a)

The Examiner rejected claims 170-278, 280-281, and
283-284 under 35 U.S.C. § 103(a) as being unpatentable over

Withnall "in view of the general teachings of the prior art of record." (February 28, 2003 Office Action Summary, p. 4). Applicants respectfully disagree and submit that none of the aforementioned claims are obvious in view of Withnall, Veeneman, Montanari, and Sangster. In order for a claimed invention to be obvious in view of a combination of references, three criteria must be met: 1) there must exist a suggestion or motivation to modify the reference or to combine reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art references, when combined, must teach or suggest all of the claim limitations (see *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)) (see also Manual of Patent Examining Procedure §§ 2143-2143.03).

Initially, Applicants submit that no suggestion or motivation to modify or combine Withnall, Veeneman, Montanari, and Sangster exists.

"Standing on their own, these references provide no justification for the combination asserted by the Examiner. "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so." ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984) (Emphasis in original).

The Examiner contended that it would have been obvious to combine the teachings of Withnall, Veeneman, Montanari, and Sangster to arrive at the various embodiments of Applicants' invention. Yet, the Examiner has not pointed
5 to what motivation is provided by the references themselves. Applicants submit that no combination of these references would have been obvious to one of skill in the art at the time of Applicants' invention, especially because no motivation or suggestion for combining these
10 references exist within the references themselves. Specifically, Withnall discloses a system for easing the examination of commuter tickets for validity. This purpose is far removed from the intent of the gift registry system of Veeneman, which allows users to register items from a
15 catalogue. Withnall and Veeneman relate in no way to Montanari which discloses a system for tracking food products. Additionally, these three references have no apparent relation to Sangster which discloses a video training system utilizing a videodisc player that is
20 connected to multiple student stations. The differing purposes of these references have no overlap in use, and therefore, would not provide one skilled in the art with a motivation or suggestion to combine these references. Thus, an inventive step must be performed for one skilled

in the art to arrive at the idea of combining any features of Withnall, Veeneman, Montanari, and Sangster in any combination.

Upon reconsideration, the Examiner will undoubtedly
5 recognize that the reasons put forth for the § 103(a) rejection actually support an "obvious to try" argument. Of course, "obvious to try is not the standard for obviousness under 35 U.S.C. § 103." Hybritech, Inc. v. Monoclonal Antibodies, Inc., 231 U.S.P.Q. 81, 91 (Fed. Cir.
10 1986).

Under these circumstances, Applicants respectfully submit that the Examiner has succumbed to the "strong temptation to rely on hindsight." Orthopedic Equipment Co. v. United States, 702 F. 2d 1005, 1012, 217, U.S.P.Q. 193,
15 199 (Fed. Cir. 1983):

"It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claim in suit.
20 Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law."

Applicants submit that the only suggestion or
25 motivation for the Examiner's combination of references is provided by the teachings of Applicants' disclosure. No such suggestion or motivation is provided by the references

themselves; nor could there be in view of the difference in subject matter and the corresponding goals thereof.

In addition to the lack of suggestion or motivation to combine Withnall, Veeneman, Montanari, and Sangster, there
5 is no expectation of success for the combination of these references, and any possible resulting device would not teach or suggest all of the limitations of the rejected claims. Withnall discloses a machine capable of scanning a bar code on a commuter ticket and subsequently displaying
10 the validity of the ticket based on information stored in a memory means. Applicants respectfully submit that Withnall and any of the cited references cannot be successfully combined to disclose the programming material of the claimed invention. Importantly, base claims 168, 279, and
15 282 all disclose the accessing of programming material resulting from recognition of a machine recognizable feature. The programming material of the present invention is designed such that it can be easily altered or updated at any time. As a result, a user will be provided with the
20 most recently updated version of the associated information (or programming material) upon scanning a printed ticket of admission. This is not possible with any combination of Withnall, Veeneman, Montanari, or Sangster. Any attempt of providing programming material by implementing the

videodisc player of Sangster with Withnall would require the videodisc player to be located on a vehicle, e.g., a bus. Therefore, anytime information must be updated, a new videodisc must be inserted into the videodisc player. This is not feasible, especially because the validity of a ticket can change each time a ticket is used and could require a new videodisc to be employed every time a ticket is used. Moreover, the radio data link of Withnall cannot be utilized to access a remote videodisc player or other such audio/visual material because the radio data link is designed only for transmitting a validity state and not substantially different audio/visual material. In particular, audio/visual material requires substantially more data to be transmitted in a specialized format. Thus, a system for achieving such transmission would need to be invented and implemented for remotely accessing such material.

Furthermore, the gift registry system and printing system of Veeneman and the food product tracking system of Montanari does not in any way disclose programming material as claimed. Therefore, the combination of these references with Withnall would not be successful for creating a system that accesses programming material as taught by the pending claims.

In sum, any attempt to combine Withnall, Veeneman, Montanari, and Sangster to create the present invention would be unsuccessful and fail to provide the flexible, updateable system including a system for obtaining and
5 surveying correlated programming material of the claimed invention as opposed to a comparison of the identity of a printed code with a code stored in a database. Moreover, the dynamic programming material of the claimed invention is not disclosed by the combination of these references.

10 In view of the foregoing, base claims 168, 279, and 282 cannot be unpatentable over Withnall, Veeneman, Montanari, and Sangster. The remaining rejected claims are dependent on these claims and contain all of the limitations of their respective base claims. Therefore,
15 these dependent claims are also not unpatentable over these references.


CONCLUSION

Applicants submit that all pending claims represent a patentable contribution to the art and are in condition for allowance. No new matter has been added. Early and
5 favorable action is accordingly solicited.

Respectfully submitted,

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